

REMARKS

The foregoing amendments and the following remarks are submitted in response to the communication dated January 13, 2005.

Status of the Claims

Claims 21, 24, 26-28, 34-48, 51, 52 and 67 are pending in the application. Claim 22 has been cancelled without prejudice. Claims 24, 27, 34 and 67 have been amended in order to more particularly point out and distinctly claim that which Applicants regard as the invention. Support for the amended claims can be found generally through Applicants' specification.

New Rejections

New Claim Rejections – 35 USC §112

Claims 24, 26, 27, 36, 38, 40, 42, 44, 46, 48 and 52 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner remarks that these claims are indefinite because they encompass a DNA molecule encoding a leptin receptor that is "amplifiable" under non-specified conditions. Applicants respectfully disagree and assert that a molecule amplifiable by PCR with specified and particular primers is clear to the skilled artisan, as the artisan would know and understand the standard and recognized conditions for PCR amplification. In addition, the Specification, including at pages 81-82, provides exemplary conditions for PCR amplification using the specified primers. Applicants, however, have above amended claim 24, without prejudice to continued prosecution, above deleting the objected to language, and submit that this rejection is now moot.

In view of the foregoing remarks and amendments, Applicants submit that the Examiner's above new rejection under 35 U.S.C. §112, second paragraph, may be properly withdrawn.

New Claim Rejections - 35 USC §102

Claims 24, 26, 36, 38, 40, 42, 44, 46, 48 and 52 are rejected under 35 U.S.C. §102(e) as anticipated by Tartaglia et al [U.S. Patent 6,506,877, filed December 28, 1995]. The Examiner

takes the position that Tartaglia et al. teaches or anticipates these claims encompassing an isolated nucleic acid which is a soluble receptor and which is encoded by a nucleic acid which is amplifiable with a PCR probe selected from a probe for clone seven and a probe for clone 11 or both, nucleic acids that hybridize to a DNA molecule of SEQ ID NO: 9, expression vectors, which may be transgenic, host cells that may be E. coli, Saccharomyces, Pichia, CHO cells, and method of preparing polypeptide recombinantly. Applicants respectfully disagree. Applicants, however, have above amended claim 24, without prejudice to continued prosecution, and submit that the claims as now presented are not anticipated by Tartaglia et al. In particular, reference to amplifiable and hybridizable nucleic acids has been deleted from the claim 24 language, and is further not now relevant in the other rejected claims, all dependent from claim 24.

In view of the foregoing remarks and amendments, Applicants request that this new 35 U.S.C. §102 rejection be withdrawn.

Maintained Objections and Rejections

The Double Patenting Rejection

Claims 21, 22, 24, 26-28, 34-48, 51, 52 and 67 remain provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 29-31 of copending Application Serial No. 08/783,734("the '734 Application"). The Examiner remarks that there are no size limitations for the claimed oligonucleotides of the '734 Application, so they read on the nucleic acids in the instant Application. Furthermore, the Examiner remarks that even if the sizes of the oligonucleotides were limited, it would be *prima facie* obvious to the skilled artisan to make smaller fragments to use as probes in hybridization experiments. Applicants respectfully disagree and again submit that, in as much as the pending claims in the instant Application cover nucleic acids coding on expression OB-Re, these are patentably distinct from the oligonucleotides hybridizable to OB-Re claimed in claims 29-31 of the copending '734 Application. However, in order to facilitate the conclusion of the prosecution of the instant Application and as requested by the Examiner, Applicants submit herewith a Terminal Disclaimer to Obviate a Provisional Double Patenting Rejection Over a Pending Second Application with respect to the copending '734 Application.

The Specification Fully Enables the Claimed Invention

Claims 21, 22, 24, 26-27, 34-48, 51, 52 and 67 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner remarks that the issue in this rejection is that of written description, requiring a "precise definition such as by structure, formula, chemical name, or physical properties" in the Specification. Applicants respectfully disagree and submit that the claims, particularly as amended and presented herein, contain subject matter which was described in the specification in such a way as to convey to the skilled artisan that the inventors had possession of same at the time of filing. Each and any of the nucleic acids claimed in the instant Application meets the written description requirement, having a precise definitive as to structure or formula, particularly herein as to nucleic acid sequence.

In view of the foregoing remarks, Applicants submit that the Examiner's rejections under 35 U.S.C. 112, first paragraph, may properly be withdrawn.

Particularity and Distinctiveness of the Claims

The Examiner has rejected claims 24, 36, 38, 40, 42, 44, 46, 48 and 52 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. The Examiner asserts that Applicants amendment of claim 24 to refer to DNA which hybridizes under moderate stringency conditions is still indefinite, because the Specification's conditions are exemplary and do not have clear metes and bounds. Applicants respectfully disagree, however, in an effort to facilitate prosecution of this instant Application and without prejudice to continued prosecution, Applicants have above amended claim 24. Applicants assert that the Examiner's rejection of claim 24 is now moot, and may properly be withdrawn.

In view of the foregoing remarks and amendments, Applicants request that the Examiner's rejections under 35 U.S.C. 112, second paragraph, be withdrawn.

The 35 USC §102 Rejection

Claims 22, 24, 26, 34, 48, 51 and 52 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tartaglia et al [U.S. Patent No. 6,506,877, filed December 28, 1995]. In particular, the Examiner asserts that claim 22 is so broadly written and does not require any sequence and therefore Tartaglia anticipates claim 22. Applicants have above cancelled claim 22, without prejudice to continued prosecution, and have above amended claims 34 and 67 to remove dependency from now cancelled claim 22. Applicants submit that the Examiner's rejection under 35 U.S.C 102(e) is now moot and may properly be withdrawn.

CONCLUSION

Applicants respectfully request entry of the foregoing amendments and remarks in the file history of the instant Application. The Claims as amended are believed to be in condition for allowance, and reconsideration and withdrawal of all of the outstanding rejections is therefore believed in order. Early and favorable action on the claims is earnestly solicited.

Respectfully submitted,

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